

REMARKS

Claims 1, 2, 5-10, 13-20, 22-27, 29-36, 39-44, and 47-52 were pending in this application. Claims 1, 9, 16-19, 26, 33-35, 43, 48, and 51-52 have been amended. Claims 53-64 have been added. With the entry of the claims submitted herewith, claims 1, 2, 5-10, 13-20, 22-27, 29-36, 39-44, and 47-64 will be pending. Reconsideration of the present application is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 1, 2, 5, 9-10, 17-20, 22, 26-27, 29, 33-36, 39, 43-44, 47, and 51-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,317,761 to Landsman *et al.* ("Landsman") in further view of U.S. Pat. App. Pub. No. 2001/0005855 to Shaw *et al.* ("Shaw"). Applicants respectfully submit that the applied references fail to teach or suggest each and every limitation recited by independent claims 1, 9, 17-19, 26, 33-35, 43, and 51-52. In particular, the claims have been amended to recite: "retrieving, responsive to the programmable creative definition, proprietary information from a private database in the server-side system and including at least a portion of the proprietary information in the [programmable] creative." Neither Landsman nor Shaw disclose retrieving proprietary information from a server-side private database and including the proprietary information in a creative, as required by the claims.

The Office Action acknowledges that Landsman "fails to specifically disclose including at least a portion of the proprietary data in the creative." (Office Action, p. 5, lines 8-9.) Thus, to cure the deficiencies of Landsman, the Office Action applies the teachings of Shaw, which according to the Office Action, "discloses banner advertisements [] in a proprietary format." (*Id.*, p. 5, lines 14-16.) Specifically, as cited by the Office Action, Shaw explains: "The banner and showcase advertisements may be textual, graphical, or video data (or combinations thereof) and may be stored in a standard compressed data format, such as JPEG or MPEG, or in a proprietary format, or in an uncompressed format." Shaw, paragraph [0098]. While Shaw may disclose advertisements that are stored in a proprietary format, it fails to teach or suggest a server-side private database that provides proprietary information to be included in advertisements as required by the claims. Storing an advertisement in a particular format is clearly distinguishable from including particular information in an advertisement. For example, the proprietary information claimed in new dependent claims 53-64 provides text that is displayed by the creative.

Additionally, the claims require that the private database is in the server-side system. In general, the claims recite various limitations that occur on a server-side system. The Office Action

acknowledges that "Landsman et al fails to disclose performing the limitation on the server side system." (Office Action, p. 4, lines 6-7.) However, the Office Action asserts:

On the other hand, Landsman discloses a client/server architecture in a networked environment (Col 15, lines 48-51) wherein the server can be a separate software application which executes on any computer in the networked environment. (Column 15, lines 61-64) Therefore, it was well-known to one of ordinary skill in the art at the time of Applicant's invention that the functionality of a client/server architecture is applicable and interchangeable between a client and a server since there is no real significant differences between a client and a server. In addition, one of ordinary skill in the art would not see any reason why certain data processing techniques, once taught, cannot or should not be applied to either the client or server side of a system. Each side contains a data processing unit and techniques for one processing unit may very well be applicable to other data processing units; therefore, a program tailored to be executed on a client can also be executed on a server.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modified Landsman's method to perform on a server since it would have provided the benefit of taking advantage of server capabilities of management and distribution duties with other client that a server provides to a client.

(*Id.*, p. 4, line 7-p. 5, line 2.) Functionality is not interchangeable between a client and a server in the manner suggested by the Office Action. In particular, keeping proprietary information in a private database as recited in the present claims is not a function that is interchangeable between a client and a server. Due to the proprietary nature of the information, a private database storing the information would be kept in a more secure server-side system (e.g., behind a corporate firewall or located internally within a secure corporate network), and not in a client-side system. Indeed, Landsman fails to teach or suggest proprietary information in a server-side private database, because Landsman focuses on the features of client-side systems, which are not suitable for storing a private database with proprietary information. As such, Landsman actually teaches away from combining its client-side features with a private database with proprietary information.

The present Specification sets forth the following distinctions between a client-side system and a server-side system:

Client-side programmable technology uses software programs that are authored on the server-side (either by the publisher or the advertiser or advertising agency), but are delivered to the client and executed on the client-side. Exemplary client-side programming platforms include Java™, JavaScript and Flash™. Each constitutes an executable program which is downloaded into a client web browser along with an HTML web page and executed on that client computer. During execution, the programs may, for example, deliver motion video and/or audio and/or special effects. Their execution can create the appearance of something 'special' selected for the viewer. However, client-side programs have significant limitations to their flexibility and customizability. In particular: once downloaded, communication back to the publisher's internal data sources requires impractical server security configuration. Hence, it's not practicable to dynamically include private, internal data in client-side programmable creatives. Further, client-side programmable creatives typically require special

client-side web browser plug-in software and resources to execute.

Server-side programmable creatives, by comparison, require no additional client-side software or resources; perhaps more importantly, they have access to the publisher's private, internal data sources.

(present Specification as published, paragraphs [0012]-[0013].) In general, client-side systems and server-side systems are different with respect to security and data access, *e.g.*, vis-à-vis proprietary information and private databases. Due to the distinctions between client-side systems and server-side systems, however, one of ordinary skill in the art would fail to contemplate implementing the features of the client-side systems in Landsman on a server-side system. Advantageously, the claimed invention allows advertisements to be programmed with centralized access to proprietary information from a server-side private database and to be generated on a server-side system with the proprietary information.

Because neither Landsman nor Shaw discloses retrieving proprietary information from a server-side private database and including the proprietary information in a creative, withdrawal of the rejection of independent claims 1, 9, 17-19, 26, 33-35, 43, and 51-52 is in order and is respectfully requested. In addition, Applicants respectfully submit that dependent claims 2, 5-8, 10, 13-16, 20, 22-25, 27, 29-32, 36, 39-32, 44, 47-50, and 53-64 are also allowable at least for the same reasons as their respective base claims 1, 9, 17-19, 26, 33-35, 43, and 51-52.

Conclusion

It is Applicants' belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

Date: December 16, 2009

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